

REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claim 1 has been amended to further clarify the invention. No new issues necessitating another search should arise from the amendment. Accordingly, applicant requests that the amendment be entered and amended claim 1 examined on its merits.

Claims 1 and 3 were rejected under 35 U.S.C. §102(b) as being anticipated by Martin (U.S. 5,796,848). For the following reasons, the rejection is respectfully traversed.

As amended, claim 1 recites a microphone encapsulated in an "electromagnetic shielding case (3)" (line 3), and an "analog/digital converter (5)" which is "mounted on an *outside* of the electromagnetic shielding case (3)" (lines 4-5, emphasis added). Martin clearly has its A/D converter 7 mounted *within* the shielded case 9. Accordingly, claim 1 is patentable over the reference. Claim 3, which depends on claim 1, is thus patentable over the reference for the same reason, as well as for the limitations contained therein. Claims 2, and 4-7, being directly or indirectly dependent on claim 1, are patentable over the reference for the same reasons, as well as for the limitations contained therein.

Claims 1, 4, & 7 were rejected under 35 U.S.C. §103(s) as being unpatentable over Gnecco *et al.* (U.S. 6,031,923) in view of Brennan *et al.* (U.S. Pat. No. 6,236,731). For the following reasons, the rejection is respectfully traversed.

As discussed above, claim 1 recites a microphone encapsulated in an "electromagnetic shielding case (3)" (line 3), and an "analog/digital converter (5)" which is "mounted on an *outside* of the electromagnetic shielding case (3)" (lines 4-5, emphasis added). As admitted in the Office action, neither Gnecco nor Brennan teach an ADC mounted on an electromagnetic shielding case, as claimed.

The Office action claims that mounting an electromagnetic shielding case on an outside of a shielding case would be obvious for reducing electromagnetic noises. However, no suggestion or motivation in the reference is provided for mounting the ADC on an "outside" of the electromagnetic shielding case. Further, a prima facie case of obviousness is not supported by merely providing a benefit to a proposed modification to the cited references, there must be some suggestion provided for the modification itself, and none was provided (See MPEP §2143.03). Accordingly, because not all claim limitations were suggested by the references, claim 1 is patentable over the combination. Claims 2-7, which depend, directly or indirectly, on claim 1, and thus patentable for the same reasons, as well as for the limitations contained therein.

Further, the Examiner has provided no motivation for combining the references, and thus the combination is improper.

Claims 2-3 & 5-6 were rejected under 35 U.S.C. §103(s) as being unpatentable over Gnecco *et al.* (U.S. 6,031,923) in view of Brennan *et al.* (U.S. Pat. No. 6,236,731) and further in view of Husung (U.S. Pat. No. 5,809,151). For the following reasons, the rejection is respectfully traversed.

None of the references suggest an ADC mounted on an electromagnetic shielding case, as claimed in claim 1, upon which claims 2-3 and 5-6 depend (directly or indirectly). Thus, claims 2-3 and 5-6 are patentable over the references. Further, no motivation has been provided for combining the references as suggested by the Examiner, and thus the combination is improper.

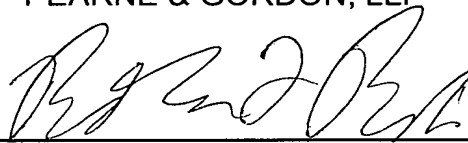
In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32396.

Respectfully submitted,

PEARNE & GORDON, LLP

By: _____

A handwritten signature in dark ink, appearing to read 'R. F. Bodi', is written over a horizontal line.

Robert F. Bodi, Reg. No. 48540

526 Superior Avenue, East
Suite 1200
Cleveland, Ohio 44114-1484
(216) 579-1700

December 27, 2002

Claim Amendments with Editing Marks

1. (thrice amended) A hearing aid with a microphone system (1) and a subsequent analog/digital converter (5), wherein the microphone system (1) is encapsulated in an electromagnetic shielding case (3) forming a shielded microphone system unit and further wherein and the analog/digital converter (5) is mounted on an outside of the electromagnetic shielding case (3)